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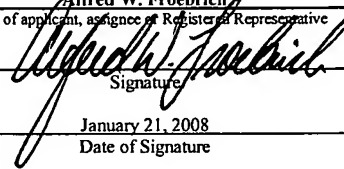
Attorney Docket # 3397-94PDV4

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of  
Vilho NISSINEN et al.  
Serial No.: 10/687,194  
Filed: October 16, 2003  
For: Use of recycled calcium carbonate in the  
treatment of a paper, board or nonwoven product

Examiner: HALPERN, Mark  
Group Art: 1731

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Alfred W. Froebrich  
Name of applicant, assignee or Registered Representative  
  
Signature  
January 21, 2008  
Date of Signature

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**APPEAL BRIEF**

SIR:

This is an appeal, pursuant to 37 C.F.R. § 41.37 from the decision of the Examiner in the above-identified application, as set forth in the Final Office Action dated March 19, 2007 wherein the Examiner finally rejected appellant's claims. The rejected claims are reproduced in the Appendix A attached hereto. A Notice of Appeal was filed on September 21, 2007.

The fee of \$510.00 for filing an Appeal Brief pursuant to 37 C.F.R. § 41.20 is submitted herewith. Appellants request a two-month Extension of Time of the original shortened statutory response period to file this Appeal Brief. A Petition for the two-month extension of time is

enclosed herewith along with the fee of \$460.00. Any additional fees or charges in connection with this application may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

#### **REAL PARTY IN INTEREST**

The assignee, Metso Paper Oy, is the real party of interest in the above-identified U.S. Patent Application.

#### **RELATED APPEALS AND INTERFERENCES**

There are no other appeals and/or interferences related to the above-identified application at the present time.

#### **STATUS OF CLAIMS**

Claims 1-61 are cancelled. Claim 62 has been rejected. Claims 63-64 are currently withdrawn as being drawn to a non-elected invention. Claim 62 is on appeal.

#### **STATUS OF AMENDMENTS**

A response to the Final Office Action which contained no Amendments was filed on July 18, 2007. The Examiner issued an Advisory Action on July 23, 2007 maintaining the rejections in the Final Office Action. A Pre-Appeal Brief Request for Review was filed with the Notice of Appeal on September 21, 2007. A Notice of Panel Decision issued on October 10, 2007 indicating that the application remains under appeal because there is at least one actual issue for appeal.

## **SUMMARY OF THE CLAIMED SUBJECT MATTER**

Appellants' invention is directed to a use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product (see page 6, line 35 to page 7, line 5 of the present application as originally filed).

According to the present invention, a paper, board, or nonwoven product is treated with the recycled calcium carbonate (see page 5, lines 25-27 and page 6, line 35 to page 7, line 5 of the present application as originally filed). As stated in original claim 59, and as described in the second paragraph on page 4 of the preliminary amendment to the specification filed with the application, the recycled calcium carbonate is prepared by calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board or non-woven product, reacting the lime with water to form calcium hydroxide, and reacting the calcium hydroxide with carbon dioxide to form the recycled calcium carbonate.

## **GROUND OF REJECTION TO BE REVIEWED IN APPEAL**

1. Whether claim 62 is indefinite under 35 U.S.C. §112, second paragraph?
2. Whether claim 62 is anticipated under 35 U.S.C. §102 by U.S. Patent No. 5,795,258 (Sohara)?

## **ARGUMENT**

### **Rejections under 35 U.S.C. §112**

Claim 62 stands rejected under 35 U.S.C. §112, second paragraph, as indefinite. More specifically, the Examiner alleges claim 62 is non-statutory because it includes the USE and the METHOD OF MAKING of recycled calcium carbonate. Reconsideration of this rejection is respectfully requested.

35 U.S.C. §100(b) defines the term “process” for the U.S. Patent laws and states: “The term ‘process’ means process, art or method, and includes a new use of a known process, machine, manufacture, composition or material, or material”. Thus, a use is merely a subset of the group of statutory classes defined as process claims. Accordingly, within the context of the disclosed invention, claim 62 defines a process of using the recycled calcium carbonate to treat a paper, board or nonwoven product.

Furthermore, the use recycled calcium carbonate for treatment of a paper, board or nonwoven product requires obtaining the recycled calcium carbonate. The steps for obtaining or preparing the recycled calcium carbonate to be used are properly recited as a part of the overall claimed process for the use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product. In view of the foregoing, claim 62 directed to a process of using recycled calcium carbonate which recites how the recycled calcium carbonate is obtained is neither indefinite nor non-statutory.

Accordingly, the rejection of claim 62 under 35 U.S.C. §112 should be withdrawn.

#### **Rejection of Claims under 35 U.S.C. §102**

Claim 62 stands rejected under 35 U.S.C. §102 as anticipated by U.S. Patent No. 5,759,258 (“*Sohara*”).

The Examiner states that *Sohara* discloses forming calcium carbonate from the residues of deinking of wastepaper process and using the formed recycled calcium carbonate for treatment of paper. However, Applicant notes that the specific step of “calcining into lime” for preparing the recycled calcium carbonate recited in claim 62 is not disclosed by *Sohara*.

*Sohara* discloses that a deink residue (DIR) is first heated and then turned to mineral ash (see col. 3, lines 35-40). The mineral ash is then used by *Sohara* to form the precipitated calcium

carbonate (PCC) (see col. 3, lines 40-48 and 62-67; and col. 4, lines 1-9). Cols. 6-7 of *Sohara*, which are referred to by the Examiner in the rejection, also disclose that the DIR is incinerated to produce mineral ash, which is subsequently used for forming PCC (see e.g., col. 6, lines 37-42; and col. 7, lines 58-67).


Since *Sohara* discloses heating deink residue to form mineral ash, *Sohara* fails to disclose, teach, or suggest "calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board, or nonwoven product", as recited in independent claim 62.

Accordingly, independent claim 62 is deemed allowable, and withdrawal of the rejection of claim 62 under 35 U.S.C. §102(b) is in order.

### **CONCLUSION**

For the foregoing reasons, it is respectfully submitted that appellants' claims are not anticipated by and are, therefore, patentable over the art of record, and the Examiner's rejections should be reversed.

Respectfully submitted,  
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Dated: January 21, 2008

## CLAIMS APPENDIX

1.-61. (canceled)

62. (previously presented) A use of recycled calcium carbonate in the treatment of a paper, board or nonwoven product, comprising:

treating the paper, board, or nonwoven product with the recycled calcium carbonate, the recycled calcium carbonate being prepared by calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board or non-woven product; reacting the lime with water to form calcium hydroxide; and reacting the calcium hydroxide with carbon dioxide to form the recycled calcium carbonate.

63. (withdrawn) A method of treating a paper, board or non-woven product using recycled calcium carbonate, comprising:

treating a paper, board, or nonwoven product with the recycled calcium carbonate, the recycled calcium carbonate being prepared by calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of the paper, board or non-woven product; reacting the lime with water to form calcium hydroxide; and reacting the calcium hydroxide with carbon dioxide to form the recycled calcium carbonate.

64. (withdrawn) A method of preparing recycled calcium carbonate, comprising:

calcining into lime precipitated calcium carbonate residue of a deinking process of recycled fiber of a paper, board or non-woven product;

reacting the lime with water to form calcium hydroxide; and

reacting the calcium hydroxide with carbon dioxide to form the recycled calcium carbonate.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None